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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/812,628
Filing Date: March 20, 2001
Appellant(s): LAWRENCE, DAVID

Randolph P. Calhoune
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 2, 2007 appealing from the Office action mailed June 21, 2006

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The Examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

An Amendment After Final was filed on August 21, 2006. However, no amendments were made to the claims.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

Appellant incorrectly indicates the rejection of claims under 35 USC 103(a) as being patentable over Stewart and further in view of Greene. Claims 4, 10 and 16-19 are indicated, but should refer to 4, 10, 14 and 16-19.

Other indications of claim rejections as set forth by Appellant are correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US Publication No. 2003/0135457 to Stewart et al.

US Publication No. 2002/0143686 to Greene et al.

Dictionary of Economics by Wiley from www.xreferplus.com.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3, 5-9, 11 and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number US 2003/0135457 A1 to Stewart et al. (further referred to as Stewart).

Regarding claim 1, Stewart discloses a computer-implemented method (paragraphs 6, 7 and 9) to manage risk (paragraphs 20 and 49) related to opening a client account (paragraphs 7 and 9), the method comprising receiving digital information (paragraph 7) into a computer system relating to a client seeking to open the client account (paragraphs 7, 9 and 17); structuring the received digital information to a risk quotient criteria (paragraphs 43 and 45) associated with reputational risk of opening the client account (paragraphs 7, 19-20); associating a weight with the risk quotient criteria (paragraph 20 where it is well known to those skilled in the art that logistic-regression modeling uses weights for making predictions); calculating a risk quotient based on the structured information and the weight associated with the risk quotient criteria (paragraphs 20 and 49); and generating a suggested action in response to the calculated risk quotient (paragraphs 20, 49 and 50).

Stewart does not specifically disclose wherein said reputation risk relates to a professional standing in an industry of an account opening entity. However, Stewart

discloses the providing of personal information and where a customer is evaluated and a determination of products for which the customer qualifies is made dynamically (paragraphs 7 and 17-20). It would be obvious to one of ordinary skill in the art that reputation risk related to one's professional standing would be a factor in making the determination of opening an account. For example, if a client were known in the industry to commit white-collar crimes and to have embezzled funds through a previous account, a higher reputational risk would be placed on that client and it would be less likely that a fellow banker would open an account for that individual. If a client, on the other hand, were known to be honest and to engage in only legal practices and to be in a stable financial situation, the reputational risk would be low and it would be more likely that a fellow banker would open an account for that individual. The practice of knowing industry colleagues' reputations, and making decisions using that information, is an old and well known practice. Including this risk as a factor is a risk quotient criteria for determining whether to open an account would be obvious and higher reputational risk would move the quotient such that the likelihood of opening an account would be lower, where a lower reputational risk would move the quotient such that the likelihood of opening an account would be higher.

Regarding claim 2, Stewart discloses a method further comprising storing data comprising the received information, the risk quotient, and the suggested action in a risk quotient criteria database (paragraphs 45 and 56); and generating a due diligence report based upon the stored data (paragraph 56).

Regarding claim 3, Steward discloses a method wherein the due diligence report comprises a history of inquiries made relating to the client account and actions taken responsive to the risk quotient (paragraph 56).

Regarding claim 5, Stewart discloses the method wherein the received information is received from a source of electronic data (paragraphs 17 and 18).

Regarding claim 6, Steward discloses the method wherein the suggested action is responsive to the received information (paragraphs 18, 20, 49 and 50).

Regarding claim 7, Stewart discloses the method wherein the suggested action is directed towards reducing at least one of a financial, legal, regulatory, and reputational risk associated with the client account (paragraphs 7, 17-21, 43 and 49).

Regarding claim 8, Stewart discloses the method wherein the suggested action comprises blocking an opening of the client account (paragraph 49).

Regarding claim 9, Stewart discloses the method wherein the suggested action comprises notifying an authority concerning the received information (paragraph 49).

Regarding claim 11, Stewart discloses the method further comprising performing a calculation on the risk assumed by a financial institution as represented by the risk quotient (paragraphs 49 and 61 claim 5).

Regarding claim 20, Stewart discloses a computer executable program code residing on a computer-readable medium, the program code comprising instructions for causing the computer to receive digital information (paragraph 7) into the computer relating to a client account (paragraphs 7, 9 and 17); structure the received digital information according to a risk quotient criteria (paragraphs 43 and 45) associated with reputational risk of opening the client account (paragraphs 7, 17-20); associate a weight with the risk quotient criteria (paragraph 20 where it is well known to those skilled in the art that logistic-regression modeling uses weights for making predictions); calculate a risk quotient based on the structured information and the weight associated with the risk quotient criteria (paragraphs 20 and 49); and generate a suggested action in response to the calculated risk quotient (paragraphs 20, 49 and 50).

Stewart does not specifically disclose wherein said reputation risk relates to a professional standing in an industry of an account opening entity. However, Stewart discloses the providing of personal information and where a customer is evaluated and a determination of products for which the customer qualifies is made dynamically (paragraphs 7 and 17-20). It would be obvious to one of ordinary skill in the art that reputation risk related to one's professional standing would be a factor in making the determination of opening an account. For example, if a client were known in the

industry to commit white-collar crimes and to have embezzled funds through a previous account, a higher reputational risk would be placed on that client and it would be less likely that a fellow banker would open an account for that individual. If a client, on the other hand, were known to be honest and to engage in only legal practices and to be in a stable financial situation, the reputational risk would be low and it would be more likely that a fellow banker would open an account for that individual. The practice of knowing industry colleagues' reputations, and making decisions using that information, is an old and well known practice. Including this risk as a factor is a risk quotient criteria for determining whether to open an account would be obvious and higher reputational risk would move the quotient such that the likelihood of opening an account would be lower, where a lower reputational risk would move the quotient such that the likelihood of opening an account would be higher.

Claims 4, 10, 14 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart, and further in view of U.S. Patent Number US 2002/0143686 A1 to Greene et al. (further referred to as Greene).

Regarding claim 4, Stewart does not disclose the method further comprising presenting a graphical user interface to a network access device; displaying questions relating to the client account on the graphical user interface; and receiving information into the computer system responsive to the questions displayed. However, Greene discloses the method further comprising presenting a graphical user interface to a

network access device; displaying questions relating to the client account on the graphical user interface; and receiving information into the computer system responsive to the questions displayed (paragraph 24). It would be obvious to one of ordinary skill in the art to combine the graphical user interface for providing customer interaction as disclosed by Greene with the on-line computer method as disclosed by Stewart. The motivation would be to use the commonly implemented graphical user interface (GUI) tool with a browser to create a method of ease for customers interfacing with the browser while applying for a new account.

Regarding claim 10, Stewart does not disclose the method wherein the received information is received electronically from an external database. However, Greene discloses the method wherein the received information is received electronically from an external database (paragraph 26). It would be obvious to one of ordinary skill in the art to combine receiving information from a database as discloses by Greene with the account opening method as disclosed by Stewart. The motivation would be to use the established technique of storing and transferring data as stored in databases in order to exchange client related data from the database instead of being entered by the client wishing to open the account.

Regarding claim 14, Stewart does not disclose the method wherein at least a portion of the received information is received in a pre-structured format. However, Greene discloses the method wherein at least a portion of the received information is

received in a pre-structured format (paragraphs 24, 25 and 26). It would be obvious to one of ordinary skill in the art to combine the method of receiving information in a pre-structured format as disclosed by Greene with the method of receiving client information as disclosed by Stewart. The motivation would be to receive information which would not require formatting following input.

Regarding claim 16, Stewart discloses a computerized system (paragraphs 6, 7 and 9) for managing risk (paragraphs 20 and 49) associated with opening a client account (paragraphs 7 and 9).

Stewart does not disclose a computer server accessible with a network access device via a communications network. However, Greene discloses a computer server accessible with a network access device via a communications network (paragraphs 20 – 26). It would be obvious to one of ordinary skill in the art to combine the computer server and network as disclosed by Greene with the on-line client account opening computer system as disclosed by Stewart. The motivation would be to utilize computer servers and networks as standard known technology in the computer field for communicating across organizations for account authorization.

Stewart discloses executable software executable on demand (paragraph 17), the software operative to cause the system to receive digital information (paragraph 7) relating to the client account (paragraphs 7, 9 and 17); structure the received information according to risk quotient criteria associated with reputational risk of opening the client account (paragraphs 7, 17-20); associate a weight with the calculated

risk quotient criteria (paragraph 20 where it is well known to those skilled in the art that logistic-regression modeling uses weights for making predictions); calculate a risk quotient based on the structured information and the weight associated with the risk quotient criteria (paragraphs 20 and 49); and generate a suggested action in response to the risk quotient (paragraphs 20, 49 and 50).

Stewart does not specifically disclose wherein said reputation risk relates to a professional standing in an industry of an account opening entity. However, Stewart discloses the providing of personal information and where a customer is evaluated and a determination of products for which the customer qualifies is made dynamically (paragraphs 7 and 17-20). It would be obvious to one of ordinary skill in the art that reputation risk related to one's professional standing would be a factor in making the determination of opening an account. For example, if a client were known in the industry to commit white-collar crimes and to have embezzled funds through a previous account, a higher reputational risk would be placed on that client and it would be less likely that a fellow banker would open an account for that individual. If a client, on the other hand, were known to be honest and to engage in only legal practices and to be in a stable financial situation, the reputational risk would be low and it would be more likely that a fellow banker would open an account for that individual. The practice of knowing industry colleagues' reputations, and making decisions using that information, is an old and well known practice. Including this risk as a factor is a risk quotient criteria for determining whether to open an account would be obvious and higher reputational risk would move the quotient such that the likelihood of opening an account would be lower,

where a lower reputational risk would move the quotient such that the likelihood of opening an account would be higher.

Regarding claim 17, Stewart discloses the computerized system wherein the software is further operative to cause the system to store data in a risk quotient criteria database, wherein the stored data includes the received information, the risk quotient, and the suggested action (paragraphs 45 and 56); and generate a due diligence report based upon the stored data (paragraph 56).

Regarding claims 18 and 19, Stewart does not disclose the computerized system wherein the network access device is a personal computer or a wireless handheld device. However, Stewart does disclose the computerized system using the internet such that any user with access to the internet can obtain access to the system (paragraphs 4, 6, 7 and 9). It would be obvious to one of ordinary skill in the art that both personal computers and wireless handless devices would be included within the set of devices by which a client would access the internet. The motivation would be to include both traditional desktop devices as well as portable devices for accessing the computerized system.

Claims 12, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart as applied to claim 1 above, and further in view of Dictionary of Economics by Wiley (1995) from www.xreferplus.com (further referred to as xreferplus).

Regarding claim 12, Steward does not disclose the method further comprising aggregating a plurality of the risk quotients in order to calculate a total risk quotient representative of a total risk assumed by a financial institution. However, xreferplus discloses the method further comprising aggregating a plurality of the "risk quotients" in order to calculate a total "risk quotient" representative of a total risk assumed by a "financial institution" (page 1, lines 1 – 45 and page 2, lines 1-2). The method disclosed is that of determining a weighted average, which xreferplus defines, is that of combining a plurality of values in order to calculate a total value.

It would be obvious to combine the weighted average method as disclosed by xreferplus with the means of calculating a risk quotient as disclosed by Stewart in that the logistic-regression model as disclosed by Stewart uses weights in calculating values though Stewart does not discuss in detail the mathematical calculations involved within the disclosed logistic-regression model. The motivation would be to use established mathematical equations and models of combining factors in order to determine an aggregate value based on those factors.

Regarding claim 13, Steward does not disclose the method further comprising calculating an average risk quotient based on a plurality of the risk quotients. However, xreferplus discloses the method further comprising calculating an average risk quotient based on a plurality of the risk quotients (page 1, lines 1 – 45 and page 2, lines 1-2).

The reasoning for combining xreferplus and Stewart as well as the motivation are the same as discussed in claim 12 regarding weighted average calculations.

Regarding claim 15, Stewart does not disclose the method wherein the risk quotient is calculated by multiplying a numerical value representative of a risk associated with the risk criteria times a numerical value indicative of a category weighting. However, xreferplus discloses the method wherein the risk quotient is calculated by multiplying a numerical value representative of a risk associated with the risk criteria times a numerical value indicative of a category weighting (page 1, lines 1 – 45 and page 2, lines 1-2). The reasoning for combining xreferplus and Stewart as well as the motivation are the same as discussed in claim 12 regarding weighted average calculations.

(10) Response to Argument

The Appellant's arguments have been considered but are not persuasive.

Examiner also wishes to clarify Appellant's argument in Section I Applicable Law of the Arguments. Appellant incorrectly states "As will be evident from the following detailed discussion, the cited and relied upon *Lent and Walker* fail to disclose or suggest that for which the Examiner cites and relies upon them to disclose" (emphasis added). Neither Lent nor Walker are cited or relied upon in this Application.

Examiner further wishes to clarify Appellant's argument in Section II where Appellant incorrectly states "Claims 1-3, 5-9, 11 and 20 are *patentable* over Stewart, *and in further view of Greene* under 35 USC. 103(a)" (emphasis added). First, the claims were rejected as unpatentable. Second, the Greene reference was not used in the rejection of claims 1-3, 5-9, 11 and 20.

Appellant argues that the Examiner has not presented a prima facie case of obviousness. However, Examiner respectfully disagrees. As Appellant states in the Appeal Brief, "Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved (Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc. 75 F.3d 1568, 1573, 37 USPQ2d1626, 1630 (Fed. Cir. 1996)".

Examiner asserts that a prima facie case of obviousness is made in this case as the matter being disputed flows from knowledge of one of ordinary skill in the art. From In re Clinton, we find that in many, if not most, situations, there is neither a motivation to make the modification clearly articulated in the references nor an evident lack of motivation. Rather, the prior art references typically disclose elements or aspects of the claimed subject matter, but fail to specifically point the way toward the combination, substitution or other modification needed to arrive at the invention. A judgment must be made whether 'a person of ordinary skill in the art would have had sufficient motivation

to combine the individual [elements] forming the claimed [invention]." In re Clinton, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976).

Regarding claims 1-3, 5-9, 11 and 20, Appellant argues that Stewart does not disclose "wherein said reputation relates to a professional standing in an industry of an account opening entity" and that the Examiner's conclusion that "it would have been obvious to one skilled in the art that reputation risk related to one's professional standing would be a factor in making the determination of opening an account" is incorrect. Appellant also disagrees with Examiner's building of a 103 rejection in the assertion that "Stewart discloses the use of reputation in considering account opening. The consideration of credit score and credit rating are part of reputation risk". Additionally related to the issue, Appellant argues that the Examiner incorrectly applies the Appellant's definition of "reputational risk" where the Appellant states "reputational risk relates to harm that a financial institution may suffer regarding its professional standing in an industry and claims reputational risk relates to a professional standing in an industry of an account opening entity".

In addressing the disputed matter of "reputational risk" and the 103 rejection made under Stewart, the Examiner asserts that the interpretation of reputational risk and the quantification thereof are supported, in a 103 rejection, under Stewart. Stewart discloses wherein one seeking to open an account provides personal information, and wherein a customer is evaluated, and wherein a determination of products for which the customer qualifies is made. As stated in the rejection above, it would be obvious to one

of ordinary skill in the art that reputation risk related to one's professional standing would be a factor in making the determination of opening an account. This is simply common sense. Again as stated above in the rejection, if a client were known in the industry to commit white-collar crimes and to have embezzled funds through a previous account, a higher reputational risk would be placed on that client and it would be less likely that a fellow banker would open an account for that individual. If a client, on the other hand, were known to be honest and to engage in only legal practices and to be in a stable financial situation, the reputational risk would be low and it would be more likely that a fellow banker would open an account for that individual. The practice of knowing industry colleagues' reputations, and making decisions using that information, is an old and well known practice. Including this risk as a factor is a risk quotient criteria for determining whether to open an account would be obvious and higher reputational risk would move the quotient such that the likelihood of opening an account would be lower, where a lower reputational risk would move the quotient such that the likelihood of opening an account would be higher.

Evaluating the reputation risk of an individual before opening account for that individual is old and well known and is simply common sense. The Examiner does not dispute that Stewart discloses credit score and credit rating and that these two measures do not encompass the full meaning of reputational risk as being one's standing in an industry; however, as cited in the rejection, these are parts of reputational risk, as a quantifiable means of determining one's likelihood of maintaining an account where Stewart discloses determining and quantifying customer risk using logistical-

regression model (weighted factors) to predict risk associated with the potential account holder. The other aspects of reputational risk associated with one's professional standing in an industry, and taking this into account when deciding whether to open an account or not, is common sense and old and well known.

Regarding claims 4, 10, 14 and 16-19 as rejected over Stewart and further in view of Greene, and claims 12-13 and 15 as rejected over Stewart and further in view of xreferplus, Appellant argues that as these claims depend from an independent claim which Appellant believes to be allowable that these dependent claims should also be allowable. Examiner respectfully disagrees based on the arguments presented above.

Further, Appellant argues, with respect to claim 16, that the combination of Stewart and Greene fails to render claim 16 obvious. Examiner respectfully disagrees. Where Stewart discloses a computerized system for managing risk associated with opening a client account, Stewart does not disclose a computer server accessible with a network access device via a communications network. Greene does disclose a computer server accessible with a network access device via a communications network within a system for real-time account opening. Employing the real-time network communications account opening system of Greene with the computerized account opening system of Stewart is obvious as Stewart specifically discloses where "The potential customer applies on-line, providing personal information to the financial institution such as is necessary to determine whether or for which products the customer will be approved" such that the account is established electronically. While

Stewart does not say that a server accessible with a network access device via a communication network is being used, clearly communication servers are being used to facilitate the on-line, electronic application process such that information is conveyed from the potential client to the financial institution.

(11) Related Proceeding(s) Appendix

No decision rendered by a court of the Board is identified by the Examiner in the Related Appeals and Interference section of this Examiner's Answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Jennifer Liversedge

Examiner, Art Unit 3692

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